

### REMARKS

Claims 1-52 are in the application. Claims 1-52 remain unchanged from the original versions thereof. Claims 1, 18, 24-26, 33, 40, 43, and 50 are the independent claims herein. No new matter is added as a result of the amendments submitted herewith.

Reconsideration and further examination are respectfully requested.

#### **Claim Rejections – 35 USC § 112**

Claims 12 and 22 were rejected under 35 USC 112, first paragraph on the basis that while the specification is enabling for an item that cannot be disassociated from a cart, the specification does not provide enablement for not disassociating the item from the cart. The rejection further states that the specification does not enable any person skilled in the art to which it pertains, or with which it is most closely connected, to make and use the invention commensurate with the claims. This rejection is traversed.

Applicant respectfully submits that claims 12 and 22 are fully enabled by the Specification and the Specification clearly teaches those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. Further, Applicant respectfully submits that the claims are commensurate with the Specification (that is, the claims closely correspond with the description of the Specification).

It is noted that the Office Action admits that claims 12 and 22 “recite the exact wording of the specification”. Thus, it is clear that the specification is in fact commensurate with the scope of the claims.

Furthermore, it is noted that claims 1 and 12 recite a method “wherein the item cannot be disassociated from the shopping cart”. Thus, it is clear that Applicant claims a method(s) wherein an item related to the method cannot be disassociated from a shopping cart. As noted above, the Office Action admits that the specification is enabling for an item that cannot be disassociated from a cart from the shopping cart.

Since claims 12 and 22 recite an item that cannot be disassociated from the shopping cart, it logically follows that the specification is enabling for claims 12 and 22.

In support of the rejection of claims 12 and 22, the Office Action argues that the specification provides no explanation of how Applicant intends to carry out not disassociating an item from the cart. The Office Action discusses a user not being able to disassociate an item from the cart and how “[A]pplicant has not provided ample details as to what happens to an item associated with a shopping cart assuming that a consumer does not want to purchase the item and is not able to remove the item from the shopping cart.” Applicant respectfully submits that the hypothetical scenario articulated in the Office Action (and not suggested or admitted by Applicant) is irrelevant to the claims. That is, whether a user of the claimed invention does or does not purchase an item associated with a shopping cart of claims 12 and 22 “wherein the item cannot be disassociated from the shopping cart” is not stated in the claims (i.e., irrelevant, not claimed). Neither claim 12 nor 22 claims or relates to actions subsequent to not disassociating an item from a shopping cart.

Furthermore, the rejection of claims 12 and 22 is not based on any cited reference that would necessitate further details regarding the claimed methods “wherein the item cannot be disassociated from the shopping cart”. Applicant clearly and unambiguously claims an item that cannot be disassociated from the shopping cart. Applicant respectfully submits that a person skilled in the art to which claims 12 and 22 pertain, or with which they are most closely connected, would be able to make and use the invention such that an item could not be disassociated from a shopping cart (i.e., commensurate with the claims). Surely a person capable of associating an item with a shopping cart as stated in base claims 1 and 18 would be able to make and use the invention such that an item could not be disassociated from a shopping cart as stated in claims 12 and 22, respectively.

Accordingly, Applicant respectfully submits that the specification is enabling for claims 12 and 22 that a person of ordinary skill in the art would be able to make and use

the claimed invention without undue experimentation. Therefore, the reconsideration and withdrawal of the rejection of claims 12 and 22 under 35 USC 112, first paragraph is respectfully requested.

**Claim Rejections – 35 USC § 102(e)**

Claims 1-11, 13-19, 21, 23-41, and 43-51 were rejected under 35 USC 102(e) as being anticipated by McAuliffe et al. (hereinafter, McAuliffe). This rejection is respectfully traversed.

Regarding claims 1-11, 13-17, 21, 23-41, and 43-51, the Office Action states that McAuliffe discloses each and every aspect of the claims. In particular, the Office Action alleges that McAuliffe discloses a method for online shopping including the steps of associating an online shopping cart with a consumer, and associating an item with the online shopping cart wherein the associated item was not selected by the consumer for association with the shopping cart.

Applicant's independent claims relate to methods (1, 25, and 26), a medium (33), and an apparatus (43) including a shopping cart associated with a consumer wherein an item associated with the shopping was not selected by the consumer for association with the shopping cart. Independent claims 24, 40, and 50 relate to a method, a medium, and an apparatus, respectively, including a shopping cart associated with a consumer wherein an item is associated with the shopping cart in response to a selection of the item by an entity other than the consumer.

Contrary the Office Action's characterization of McAuliffe, McAuliffe does not disclose associating an item with an online shopping that is either (1) not selected by a consumer associated with the shopping cart or (2) in response to a selection of the item by an entity other than the consumer.

McAuliffe relates to a method and apparatus for providing enticements to consumers in an electronic storefront. In particular, McAuliffe discloses "once the consumer has decided to make a purchase, which can be indicated by the placement of

a good or service into an electronic shopping cart, the invention can determine one or more enticements relating to the items being purchased. Specifically, the invention can identify goods and services, collectively referred to as items, in an electronic shopping cart system. After consulting one or more enticement rules specifying which enticements correspond to the consumer transaction and the merchant's current inventory, the invention can provide the consumer with an enticement. The enticements can provide consumers with an opportunity to buy additional items which can be complementary to the items being purchased. Additionally, the enticements can entice the consumer to purchase a more expensive item alternative, referred to as up-selling; or entice the consumer to purchase a different brand item alternative, referred to as cross-selling." (See McAuliffe, paragraph [0019], ln. 1-19) McAuliffe also discloses that enticements are a form of advertising used to entice consumers with an opportunity to buy additional items, purchase a more expensive item alternative (referred to as up-selling), or purchase a different item (referred to as cross-selling). (See McAuliffe, paragraph [0007])

It is clear from the above McAuliffe disclosure that "items" selected for purchase by a consumer, and thus associated with an electronic shopping cart, are defined therein as goods and services provided for purchase. It is also clear that "enticements" are distinct from the "items" provided for purchase. While the enticements may correspond to a transaction and may even be complimentary to items being purchased, enticements are not the same as the disclosed "items" provided or offered for purchase.

McAuliffe discloses a process of offering enticements in FIG. 4 and discusses the process at paragraphs [0039] – [0042]. Therein, it is disclosed that the process begins with the consumer having selected one or more items for the purchase and having placed those items in an electronic shopping cart. The items selected for purchase and inclusion in the electronic shopping cart by the consumer are identified (e.g., step 400) and "[I]n step 410, the enticement rules can be consulted to determine the enticements associated with the identified items in the shopping cart." (emphasis added) That is, the enticements are associated with items in the shopping cart.

Thus, it is clear that McAuliffe discloses (1) a consumer selecting the items to associate with a shopping cart, and (2) the enticements being associated with items in a shopping cart. The enticements are not associated with the shopping cart but instead are associated with the items in the cart. The enticements are specifically chosen and associated with the identified items in the shopping cart according to the enticement rules. The items are selected by the consumer and associated with the cart while the enticements are determined according to enticement rules and associated with the items. Again, items and enticements are not the same.

There is no disclosure or suggestion in McAuliffe that items therein are not selected by a consumer for association with a shopping cart, as claimed by Applicant (e.g., claims 1, 25, 26, 33, and 43). McAuliffe also fails to disclose or suggest associating an item with a shopping cart in response to a selection of the item by an entity other than the consumer, as stated in Applicant's claims 24, 40, and 50. McAuliffe explicitly discloses items are selected for association with a shopping cart by a consumer and enticements are associated with items.

Regarding claims 18, 19, and 21, the Office Action also rejects these claims under 35 USC 102(e) as being anticipated by McAuliffe. Independent claim 18 relates to a method including associating an item with an online shopping cart in response to a selection of the item by an entity other than a consumer. As discussed above, McAuliffe discloses "the invention can provide the consumer with an enticement. The enticements can provide the consumer with an opportunity to buy additional items which can be complimentary to the items being purchased." (cited and relied upon by the Office Action, See McAuliffe paragraph [0007]) While the merchant/seller entity of McAuliffe may provide enticements via the system disclosed therein, McAuliffe does not disclose or suggest the merchant/seller entity associating an item with a shopping cart. The McAuliffe disclosed merchant/seller entity provides an enticement that is associated with certain items, not a shopping cart. The enticements correspond to the items selected by the consumer, as discussed at length above.

Applicant respectfully submits that dependent claims 2-11, 13-17, 19, 21, 23, 27-32, 34-39, 41, 44-49, and 51 are patentable over McAuliffe under 35 USC 102(e) for at least the reasons stated above regarding claims 1, 18, 24-26, 33, 40, 43, and 50.

Accordingly, the reconsideration and withdrawal of the rejection of claims 1-11, 13-19, 21, 23-41, and 43-51 under 35 USC 102(e) are respectfully requested, as is the allowance of the claims.

**Claim Rejections – 35 USC § 103(a)**

Claims 20, 42, and 52 were rejected under 35 USC (a) as being unpatentable over McAuliffe in view of Batachia et al. (hereinafter, Batachia). This rejection is traversed.

Inasmuch as McAuliffe does not disclose or suggest that for which it is cited and relied upon for disclosing regarding the independent claims (discussed in detail above), and claims 20, 42, and 50 are dependent claims, Applicant respectfully submits that combining the disclosure of McAuliffe with the alleged disclosure of Batachia (not admitted by Applicant) does not render claims 20, 42, and 50 obvious under 35 USC 103(a). That is, the basis for the rejection does not support the rejection of claims 20, 42, and 50.

Accordingly, the reconsideration and withdrawal of the rejection of claims 20, 42, and 50 under 35 USC 103(a) are respectfully requested, as well as the allowance of same.

### CONCLUSION

Accordingly, Applicant respectfully requests allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

March 16, 2005  
Date

A handwritten signature in black ink, appearing to read "Rand P. Calhoun", written over a horizontal line.

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